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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Paul DiCarlo et al.
Serial No. : 10/791,103
Filed : March 2, 2004
Title : EMBOLIC COMPOSITIONS

Art Unit : 1773
Examiner : Leszek B. Kiliman

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO OFFICE ACTION OF JUNE 1, 2006

In response to the Office Action mailed June 1, 2006, Applicants request consideration of the following remarks.

The Examiner rejected claims 1-10, 17, 25-27 and 29-39 under 35 U.S.C. §102(b) as being anticipated by Kamiya et al., U.S. Patent No. 5,192,301 ("Kamiya").

Claims 1-10, 17, 25-27 and 29-39 cover compositions that include a generally spherical embolic particle. While the Examiner points to certain portions of Kamiya in making this rejection, none of these portions of Kamiya explicitly disclose a generally spherical embolic particle. Nor do any other portions of Kamiya explicitly disclose a generally spherical embolic particle. Further, Kamiya does not inherently disclose a generally spherical embolic particle. As stated by the United States Court of Appeals for the Federal Circuit Electro Sys. S.A. v. Cooper Life Sciences, 34 F.3d 1048, 1052 (Fed. Cir. 1994):

The mere fact that a thing *may result* from a given set of circumstances is insufficient to prove anticipation. (citations omitted; emphasis original).

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